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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/462,472 01/14/00 MATSUI

H 0010-1075-0-

EXAMINER

HM12/0328

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ART UNIT

PAPER NUMBER

1652

5

DATE MAILED:

03/28/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/462,472

Applicant(s)

Matsui et al.

Examiner

Christian L. Fronda

Group Art Unit

1652



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-13 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-13 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claim 2, drawn to a microorganism which has acquired a purine nucleoside-producing ability because of an increase of an activity of an enzyme involved in purine nucleoside biosynthesis, classified in class 435, subclass 252.33.
 - II. Claim 3, drawn to a microorganism which has acquired a purine nucleoside-producing ability because of an increase in the expression of a gene for an enzyme involved in purine nucleoside biosynthesis, classified in class 435, subclass 252.33.
 - III. Claims 4, 5, and 8, drawn to a microorganism which has acquired a purine nucleoside-producing ability because of deregulation of control of an enzyme involved in purine nucleoside biosynthesis, classified in class 435, subclass 252.33.
 - IV. Claims 9 and 10, drawn to a microorganism which has acquired a purine nucleoside-producing ability because of blockage of a reaction branching from purine nucleoside biosynthesis and leading to another metabolite, classified in class 435, subclass 252.33.
 - V. Claims 11 and 12, drawn to a microorganism which is enhanced in purine nucleoside-producing ability by weakening of incorporation of a purine nucleoside into cells of the microorganism, classified in class 435, subclass 252.33.
 - VI. Claim 13, drawn to a method for producing a purine nucleoside by fermentation comprising culturing a microorganism, classified in class 435, subclass 88.

Claim 1 is generic to Groups I-VI.

Claims 6 and 7 are generic only to Group II and Group III.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions of Groups I-V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). The inventions of Groups I-V are independent and distinct microorganisms having different mutations which result in the microorganism acquiring the ability to produce purine nucleosides. A search of each of the inventions of Groups I-V in the patent literature and the non-patent literature cannot be made without serious burden because the inventions require separate searches that have different limits, boundaries, scope, and subject matter.

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Inventions I-V and VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process for using the product as claimed can be practiced with another materially different product such as organic catalysts and organic chemicals in a chemical synthesis of purine nucleosides.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

3. Claim 1 is generic to Groups I-VI. If any of Groups I-VI are elected, then claim 1 will also be examined but only to the extent of the elected subject matter.
4. Claims 6 and 7 are generic only to Group II and Group III. If either Group I or Group II is elected, then claims 6 and 7 will also be examined but only to the extent of the elected subject matter of either Group I or Group II.
5. This application contains a claim (claim 9 of the invention of Group IV) which is directed to the following patentably distinct species of enzymes: succinyl-adenosine monophosphate synthase, purine nucleoside phosphorylase, adenosine deaminase, inosine-guanosine kinase, guanosine monophosphate reductase, 6-phosphogluconate dehydrase, phosphoglucose isomerase, adenine deaminase, and xanthosine phosphorylase. Each of these enzymes are independent chemical entities and require different literature searches.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to

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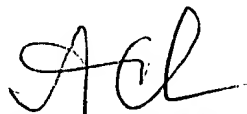
be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christian L. Fronda whose telephone number is (703)305-1252. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy, can be reached at (703)308-3804. The fax phone number for this Group is (703)308-0294. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1600 receptionist whose telephone number is (703)308-0196.

CLF


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SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600